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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,608	08/22/2003	Yoshio Sugimoto	2895-0138P	8586
2292 7590 02/21/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
02/21/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/645,608

**Applicant(s)**

SUGIMOTO ET AL.

**Examiner**

Patrick D. Niland

**Art Unit**

1796

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-5 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. The amendments of 3/28/07 and 1/4/07 have been entered. Claims 1, 3-5, and 8-11 are pending.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3-5, and 8-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6838510 Sugimoto et al. in view of US Pat. No. 6017989 Malm et al. and JP 64-40566 Baba et al. (translation provided and referenced herein). Although the conflicting claims are not identical, they are not patentably distinct from each other because although the patented claims are slightly different from those of the instant claims they differ only in obvious aspects as described below.

Sugimoto et al. claims the instantly claimed resin mixtures but is silent regarding the instantly claimed aluminum pigment and its amount. See claims 1 and 2 of Sugimoto particularly as well as the remainder of the claims.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed aluminum pigment in the resin composition of Sugimoto's claims because Sugimoto's claims recite "comprising" and thereby encompass other components, it is common to pigment such resin compositions with aluminum as taught by Malm et al., the abstract, column 1, lines 5-11 and 20-66, column 2, lines 1-36 and 66-67, column 3, lines 1-22, column 7, lines 1-67, particularly lines 25-27, 40-43 and 52-58, column 1, lines 1-5, the ordinary skilled artisan would understand the benefits this pigmentation would give to the polymer resin and would expect such benefits in the composition of Sugimoto including those benefits taught by Malm where the reduction of agglomerated pigment of column 7 would have been understood by the ordinary skilled artisan to increase the physical properties of the pigmented plastic due to the reduction of zones which act as perforations in the polymer matrix, and the coating of the instantly claimed aluminum pigments is known as taught by Baba et al., page 1, page 3, lines 5-22, page 4, lines 1-23, particularly 9-18, page 6 in its entirety, page 7 in its entirety, page 11, the entirety of "Effect of the Invention" particularly noting the described usage as filler in synthetic resin, and the benefits of this coating would have been expected in the resin composition of Sugimoto's claims where aluminum pigment is used therein. The applicant's arguments regarding examples of the instant specification are noted. These examples are not commensurate in scope with the instant claims and the cited prior art. Given the unpredictable nature of the chemical arts it is not seen that these results would have been expected in all of the compositions encompassed by the instant claims and the cited prior art particularly considering the material affect such factors as molecular weights, monomer concentrations and monomer types, filler types and amounts, etc. have on the compositions'

properties. Furthermore, it is not seen that the effect is unexpected since the compatibilization of filler with resin by surface coatings is well known to give better properties to the compositions due to the increased compatibilization as taught by Malm et al. in their reference to surface treated pigments and reduction of agglomeration of pigment discussed above.

The applicant's arguments regarding the advantages of the present invention including excellent mechanical strength, physical properties, flowability, production of molded products showing good metallic appearance and excellent and uniform compatibility where the aluminum is polymer coated. These argued properties are described in relative terms which anyone might apply to their properties including those of the prior art, e.g. good, excellent, etc. There is no probative evidence that is commensurate in scope with the cited prior art and the instant claims showing any unexpected results stemming from the use of aluminum to pigment the polymer compositions of Sugimoto et al.'s claims. A metallic appearance is expected where aluminum pigment is used. Baba et al. teaches the benefits of coating the aluminum with the instantly claimed polymer. No unexpected results stemming from this aspect of the instantly claimed invention that are commensurate in scope with the cited prior art and the instant claims showing any unexpected results stemming from the use of polymer coated aluminum to pigment the polymer compositions of Sugimoto et al.'s claims are seen. The benefits discussed by Baba et al. are expected. Example 1 and Comparative Example 1 are not commensurate in scope with the cited prior art with respect to all polymers encompassed including all polymer properties and parameters such as molecular weight, monomer sequence and amount, etc. and all ingredient amounts. The argument that the prior art is silent concerning the instantly claimed combinations of specific polymer components and specific aluminum flake pigment is not correct as these

parameters are met by the above combinations of references. It is not seen that Sugimoto et al. does not claim the argued polypropylene definitions and the applicant has not pointed out distinctly and specifically how the instantly claimed polypropylene compositions differ from the above discussed combinations of references. Regarding the applicant's contention that the above combination of references cannot be a case of obviousness, the examiner directs applicant to MPEP 2142, specifically the KSR decision. Contrary to the applicant's arguments, claims 1 and 2 of Sugimoto et al. encompass the instantly claimed components b-1 to b-3 and their amounts. Secondary references are clearly cited for the aluminum flake pigment and its polymer coating. The assertion that the combinations of references do not give the instantly claimed invention is unsupported and the applicant does not show how, by specifically and distinctly pointing out the alleged missing items, etc., the above combination of references and the cited motivation to combine them fails to give the instantly claimed invention. The applicant argues via the references independently. However, the rejection is the combination of the reference teachings, not the independent reference teachings. The applicant's arguments have been fully considered but are not persuasive for the above cited reasons.

This rejection is therefore maintained over the applicant's arguments.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/  
Primary Examiner,  
Art Unit 1796